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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE APPLICATION OF:

GROUP: 2621

Shogo HYAKUTAKE, et al.

SERIAL NO: 09/785,433

EXAMINER: PATEL, S.D.

RCE FILED: August 18, 2004

FOR: SYSTEM, COMPUTER PROGRAM PRODUCT AND METHOD FOR
MANAGING DOCUMENTS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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CKET NO: 200520US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
SHOGO HYAKUTAKE, ET AL. : EXAMINER: PATEL, S. D.
SERIAL NO: 09/785,433 :
RCE FILED: AUGUST 18, 2004 : GROUP ART UNIT: 2621
FOR: SYSTEM, COMPUTER PROGRAM :
PRODUCT AND METHOD FOR
MANAGING DOCUMENTS

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

Claims 1-5, 7-24, 26-43, and 45-78 are pending in the application.

In the Final Official Action of September 8, 2005 (hereinafter "the Final Official Action"), pending independent Claims 1, 20, 39, 58, 65 and 72 were rejected under 35 U.S.C. § 103(a) as unpatentable over Zhao et al. (U.S. Patent No. 6,141,753, hereinafter "Zhao") in view of Navarre et al. (U.S. Patent No. 6,442,611, hereinafter "Navarre").

The Final Official Action cited Zhao as disclosing the Applicant's invention with the exception of receiving, at a centralized document manager, a request for a document from a remote user.¹ The Final Official Action cited Navarre as disclosing this claimed feature, and stated that it would have been obvious to one of ordinary skill in the art at the time of the

¹ Outstanding Official Action, p. 5.

invention to combine the teachings of the cited references to arrive at the Applicant's claims.

Applicants respectfully traverse this assertion, as Zhao fails to teach or suggest the claimed features for which it is asserted as a primary reference under 35 U.S.C. § 103.

Independent Claim 1 relates to a method for managing documents, in which a request is received at a centralized document which selects an application service provider, and forwards the request to the selected application service provider. The document is then retrieved from the selected application service provider, and a merge command is sent to a printing entity requesting that the document be printed *with watermark information received from the printing entity*

Specifically, independent Claim 1 recites, *inter alia*, a method for managing documents, comprising the step of:

“...sending a merge command to a printing entity requesting that the document be printed with *watermark information received from said printing entity*.”

Independent Claims 20, 39, 58, 65 and 72 also recite substantially similar features, but are each directed to alternative embodiments of the invention. Accordingly, the arguments presented below apply to all the pending independent claims.

Turning to the primary reference, Zhao describes that a request for a document can be sent from a copy client (119i) to a copy server (103j), and the copy server then distributes the digital representation, which may include a watermark added by the copy server, to the copy client.² Once the copy client receives a copy of the digital representation they may perform various operations such as decoding, playing, printing, making a local copy, or making a derivative work of the digital representation.³

² Id., col. 6, lines 34-49, and col. 7, lines 1-14.

³ Id.

Thus, Zhao specifically describes that watermark information may be added to the digital representation at the copy server⁴, but fails to teach or suggest "...requesting that the document be printed with *watermark information received from said printing entity*", as recited in the pending independent claims.

In addressing the above noted claimed feature, the Advisory Action of December 1, 2005, cites col. 7, lines 1-13 and col. 8, lines 1-3, and, of Zhao and states:

Zhao et al. explain that the digital representation may contain a fingerprint watermark to identify the user when it is sent from the copy server to the copy client... Zhao et al. further explains that the fingerprint watermark remains in the digital representation as long as it is present in the copy client... Thus, if the fingerprint watermark is present in the digital representation, then the copy client will print the representation with the watermark. (emphasis added)

As discussed in the advisory action, Zhao describes that the watermarker (109), located in the copy server (103j) may add a fingerprint watermark to the digital representation before it is sent to the copy client (119i).⁵ Thus, the digital representation is watermarked at the copy server (103j) using a watermark locally stored in the watermarker (109) before the watermarked digital representation is sent to the copy client (119i). At no point does Zhao teach or suggest that the watermark data is received at the copy server (103j) from the copy client (119i) or "printing entity" whatsoever.

Therefore Zhao fails to teach or suggest "...sending a merge command to a printing entity requesting that the document be printed with *watermark information received from said printing entity*", as recited in independent Claim 1.

Further, Navarre is silent regarding the use of watermarks or the printing of a document. Thus, Navarre also fails to teach or suggest the above differentiated feature, as recited in the pending independent claims.

⁴ Id., col. 6, lines 18-33.

⁵ Id., Fig. 1, and col. 7, lines 1-14.

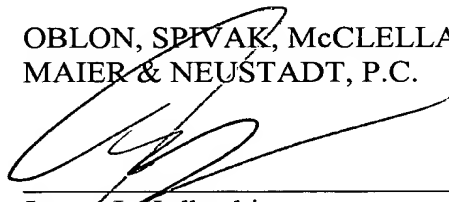
Since neither Zhao nor Navarre, neither alone, nor in combination teach or suggest "...requesting that the document be printed with *watermark information received from said printing entity*", the proposed combination of these references fails to render Claims 1, 20, 39, 58, 65, and 72 of the present application obvious. Thus, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 1, 20, 39, 58, 65, and 72.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. The dependent claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of the respective independent claim.

Based on the above-noted deficiencies in the outstanding rejections, Applicant respectfully requests that those rejections be withdrawn.

Respectfully submitted,

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